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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/845,041 | 04/27/2001 | James C. Hillegass | 2158 | 1539 |

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EXAMINER

GREENE, DANIEL L

ART UNIT PAPER NUMBER

3621

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/845,041

Applicant(s)

HILLEGASS ET AL.

Examiner

Daniel L. Greene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 2 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In claim 1 the applicant claims a method for registering a vendor's product, and issuing a product license. In claim 2 the applicant claims a method for receiving a request, assigning an identifier and issuing an item. This process might be performed without the aid of any technology and therefore the claimed method is not within the technological arts.

All that is necessary to make a sequence of operational steps in a statutory process within 35 U.S.C. 101 is that it be in the technological arts so as to be in concordance with the Constitutional purpose to promote the progress of "useful arts" *In re Musgrave*, 431 F.2d 882 167 USPQ 280 (CCPA 1970)

A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result: i.e. the method recites a step or act of producing something that is concrete, tangible and useful. See *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2d 1452.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-6, 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spagna et al. U.S. Patent 6,587,837 [Spagna].**

As per claim 1:

Spagna discloses:

registering a vendor's product by storing a product identifier in conjunction with an encryption key and providing said encryption key to said vendor to use to encrypt said product; Col. 12-13, lines 1-67.

b) issuing a product license to a user, said product license including said product identifier information, and a decryption key that mate with said encryption key. Col. 14, lines 49-67, Col. 15, lines 1-52.

Spagna discloses the claimed invention except for but not said product itself. However, Spagna does teach about the End-User Player Application 195 will wake up and initiate the start of the download process. It would have been obvious to one having ordinary skill in the art at the time the invention was made that the user has received the license without the product itself. Col./ 22, lines 1-10.

As per claims 2, 12, and 15:

Spagna discloses:

receiving a request for product registration from a vendor, said request including a product name and a vendor identifier; Col. 46, lines 25-40.

assigning a product identifier and an encryption key to said product and forwarding registration to vendor, said registration including a product identifier, said key and said vendor identifier; Col. 51, lines 15-67.

receiving a request from a user for a user license, said request including user name and payment information; Col. 79, lines 25-67.

assigning a user identifier to said user and forwarding a user license to said user, said license including said user identifier; Fig. 6.

receiving a request for a product license from said user to use said product, said request including said user identifier and said product identifier; Fig. 8.

issuing a product license to said user, said product license including a user identifier, the product identifier and a decryption key that mates with said encryption key. Fig. 8.

Spagna discloses the claimed invention except for the request including a specific product name and a vendor identifier. However, Spagna does teach about Content ID (Col. 31, lines 40-45) and Content Provider verification. Col. 14, lines 1-50. It would have been obvious to one having ordinary skill in the art at the time the invention was

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made to interchange the names Content ID with product identifier and Content Provider with vendor and effectively not change the system and methods taught.

As per claim 3:

Spagna discloses:

downloading encrypted digital material carrying a product identifier; Col. 26, lines 50-67, Col. 27, lines 1-30.

purchasing a digital license to use the material, said license including a decryption key to decrypt the material and the product identifier. Col. 29, lines 5-67, Col. 30, lines 1-33.

Spagna discloses the claimed invention except for the request including a specific product identifier. However, Spagna does teach about Content ID (Col. 31, lines 40-45) It would have been obvious to one having ordinary skill in the art at the time the invention was made to interchange the names Content ID with product identifier and effectively not change the system and methods taught.

As per claim 4:

Spagna further teaches:

obtaining a user license, said user license including a user identifier; and wherein said digital license includes said user identifier. Col. 35-36, lines 1-67.

As per claim 5:

Spagna discloses the claimed invention except for the establishing a connection for data transmission between the user's computer and a license provider's computer; transmitting via said data connection to the license provider a request for a user license including a user name and a system identifier that is unique to the user's computer; receiving via data connection a user license from the license provider, said user license including a user identifier assigned by the license provider. However, Spagna does disclose the use of technical platforms for the distribution through point-to-point and broadcast infrastructures. Col. 9, lines 65-67. It would have been obvious to one having ordinary skill in the art at the time the invention was made to realize the benefits of a system, the various parties must make connections, request information and receive data. As previously shown, each transaction entity has it's own specific ID.

As per claim 6:

Spagna further discloses:

storing the user license on said user's computer. Col. 14, lines 48-67.

As per claim 13:

Spagna further discloses: Col. 73-74, lines 1-67.

a database for storing:

(i) user license records, each said user license record including a user identifier and a system identifier; and

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(ii) product license records, each said product license record including a user identifier, a product identifier and a decryption key.

As per claim 14:

Spagna further discloses: Col. 73-74, lines 1-67.

wherein said database stores product registration records, each said record including a vendor identifier and an encryption key.

Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spagna as applied to claims 1-6, 12 and 15 above, and further in view of Knapton, III, U.S. Patent 6,363,486 B1 [Knapton].

As per claims 7 and 10:

Spagna discloses the claimed invention except for the steps of selecting and transmitting a password to the license provider and said user license incorporating said password. Knapton teaches that it is known in the art to provide the steps of selecting and transmitting a password to the license provider and said user license incorporating said password. Col. 6, lines 1-15. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the security procedures of Spagna with the steps of selecting and transmitting a password to the license provider and said user license incorporating said password of Knapton, in

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order to ensure that unlicensed copies of software components cannot operate with associated application programs.

As per claim 8:

Spagna discloses the claimed invention except for the said request including a system identifier. Knapton teaches that it is known in the art to provide said request including a system identifier. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the security procedures of Spagna with the steps of said request including a system identifier of Knapton, in order to ensure that unlicensed copies of software components cannot operate with associated application programs.

As per claim 9:

Spagna further discloses:

wherein each said user license record includes a user name. Col. 21, lines 55-67, Col. 22, lines 1-30.

As per claim 11:

Spagna further discloses:

user license record includes the user's credit card number. Col. 50, lines 13-35.

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Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

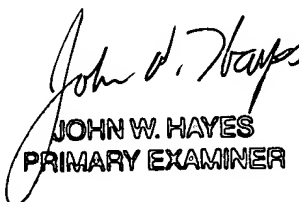
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 703-306-5539. The examiner can normally be reached on M-Thur. 8am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

11/04/03

DLG


JOHN W. HAYES
PRIMARY EXAMINER